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EXAMINER

HUNNINGS, TRAVIS R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OFER YODFAT and IDO NIR-SHAFRIR

Appeal 2016-006453
Application 11/989,677
Technology Center 2600

Before CAROLYN D. THOMAS, MICHAEL J. STRAUSS, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 38–58 and 72–75. Claims 1–37 and 59–71 are canceled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

Appellants describe the invention as a medicinal fluid delivery device and method including a command means and a dispensing unit that can include a reusable part and a disposable, reservoir part. Abstract. Software facilitates pairing and communications between the command means and the dispensing unit. *Id.* Claim 38, reproduced below, is representative of the claimed subject matter:

38. A method for pairing a dispensing unit of a fluid delivery device with a command means for controlling the dispensing unit, comprising:

initiating the pairing of the dispensing unit with the command means by sending an unpaired status message from the dispensing unit if the dispensing unit is not yet paired with a command means;

receiving an acceptance message from the command means;

checking the acceptance message to verify compatibility between the command means and the dispensing unit; and

saving identification information for the command means on the dispensing unit if compatibility is verified.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Jones	US 6,629,154 B1	Sept. 30, 2003
Simpson-Young	US 7,191,236 B2	Mar. 13, 2007
Hattori	US 2003/0045946 A1	Mar. 6, 2003

Miki	US 2005/0193228 A1	Sept. 1, 2005
Kato	US 2005/0253682 A1	Nov. 17, 2005
Koeda	US 2006/0069915 A1	Mar. 30, 2006
Teranishi	US 2006/0271833 A1	Nov. 30, 2006
Ma	US 2007/0249286 A1	Oct. 25, 2007
Jennewine	US 2008/0004601 A1	Jan. 3, 2008
McKillop	US 2008/0057890 A1	Mar. 6, 2008
Berthelsdorf	US 2008/0058900 A1	Mar. 6, 2008

REJECTIONS

The Examiner made the following rejections:

Claims 38, 39, 41, 44, 54, 55, and 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, Ma, and Kato. Final Act. 2–8, 20–23.

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, Ma, Kato, and Teranishi. Final Act. 8–9.

Claims 42 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, Ma, and Kato, and Simpson-Young. Final Act. 9–10.

Claims 45, 46, 48–50, and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, McKillop, and Kato. Final Act. 10–17.

Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, McKillop, Kato, and Koeda. Final Act. 17.

Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, McKillop, Kato, and Berthelsdorf. Final Act. 18.

Claims 52 and 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, McKillop, Kato, and Jones. Final Act. 19, 25–26.

Claims 56 and 57 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, Ma, Kato, and McKillop. Final Act. 23–25.

Claims 73 and 75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, Ma, Kato, Hattori, and Miki. Final Act. 26–28.

Claim 74 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennewine, McKillop, Kato, Hattori, and Miki. Final Act. 29–30.

APPELLANTS' CONTENTIONS

- A. Kato's pairing process is responsive to manual operation of switches such that "the pairing process is NOT initiated by sending an unpaired status message from a dispensing unit," as required by the independent claims. Br. 10.
- B. The Examiner's reasoning for modifying the combinations of Jennewine and Ma (claims 38 and 54) and Jennewine and McKillop (claim 45) to incorporate the teachings of Kato so as to produce an efficient pairing system is flawed because any reduction in power consumption "is dependent on the logic/timing sequence governing Kato's state switching" rather than the relied-upon feature of "taking the first step of connecting with the master in the pairing process." Br. 10–11.
- C. Modifying the asserted combination of references to incorporate the teachings of Kato would change the principle of operation of

Jennewine or render Jennewine inoperable for its intended purpose.

Br. 11–14.

- D. “[T]he Examiner has not established that the cited prior art would have **led** a person having ordinary skill to the invention recited in the independent claims.” Br. 14.

ANALYSIS

Appellants’ arguments are unpersuasive. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 2–50) and (2) the reasons set forth by the Examiner in the Examiner’s Answer in response to Appellants’ Appeal Brief (Ans. 2–35) and concur with the conclusions reached by the Examiner. We highlight the following for emphasis.

In connection with contention (A), Appellants argue “Kato explicitly teaches that a worker must manually start the pairing process . . . the pairing process is NOT initiated by sending an unpaired status message from a dispensing unit,” as required by the independent claims. Br. 10 (citations omitted). The Examiner responds by finding

Kato is [] not being used to teach the means by which initiation occurs as argued by Appellant. The prior art of Ma and McKillop already teach[es] initiation without the need of intervention by a human worker. Rather, Kato is being used to show that the source of the initiation may be from a slave device rather than from the master device as taught by both Ma and McKillop.

Ans. 31–32.

Appellants’ argument fails to address the Examiner’s finding that Ma and McKillop teach initiation without human intervention which, when combined with Kato, results in the overall combination teaching or

suggesting initiation by the slave device rather than the master. “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

In connection with contention (B), Appellants argue the Examiner’s reason for incorporating the teachings of Kato into the respective combinations relied upon in rejecting the independent claims, i.e., to produce an “efficient pairing system” due to the reduced power consumption, improperly relies on Kato’s logic and timing sequence because “such addition has no relation or connection to Kato’s slave set allegedly taking the first step of connecting with the master in the pairing process.” Br. 11. Appellants conclude “[t]herefore, the Examiner has only provided a conclusion that it would be obvious to modify Jennewine/McKillop and Jennewine/Ma with Kato without a **rational underpinning** since the asserted rational underpinning is defective.” *Id.* The Examiner responds by finding, contrary to Appellants’ contention, the power reduction is achieved based on the asserted modification because “the master device would not have to be constantly sending out pairing messages” but, instead, would await receipt of an initial message from the slave device. Ans. 33.

Again, Appellants’ argument fails to sufficiently address the Examiner’s findings and therefore is unpersuasive of Examiner error. As explained by the Examiner, rather than relying on a feature of Kato not related to the proposed modification, the Examiner provides reasons directed to the modification itself. Ans. 32–33. Therefore, contrary to Appellants’ argument, the Examiner has provided articulated reasoning with rationale underpinnings sufficient to support the legal conclusion of obviousness by

explaining why one skilled in the art would make the modification, i.e., because having the slave initiate pairing is a power-saving feature.

In connection with contention (C), Appellants argue “modifying Jennewine/Ma and Jennewine/McKillop with Kato’s state switching means 57, would change the principle of operation of . . . Jennewine or render Jennewine inoperable for its intended purpose.” Br. 13. According to Appellants, this is because Kato’s timing frequencies between master and slave “can be preset/dictated by the master set due to the non-critical nature of the environment in which the slave set operates” whereas, in Jennewine’s system, timing is critical because “Jennewine’s fluid delivery device 120 (the remote set) [is] in the critical environment of patient care and [is] for the purpose of synchronizing devices in their therapy management system for data communications in a global network.” *Id.*

The Examiner responds by finding Appellants’ argument is based on incorporating features of Kato not relied upon in the proposed combination. Ans. 33. The Examiner finds

[t]he only teachings of Kato that are being used in the rejection are those of the source of the initiation of a pairing process being from that of a slave, rather than a master device. In no way would such a teaching somehow render Jennewine incapable, or even any less capable, of operating in a critical environment.

Id.

Appellants’ contention (C) is unpersuasive for the reasons expressed by the Examiner as discussed *supra*. In particular, Appellants fail to provide sufficient evidence or reasoned explanation of how incorporating the proposed modification taught by Kato of having the slave initiate pairing rather than the master would either change the principle of operation of Jennewine or render it inoperative for its intended purpose. At best,

Appellants' argument is based on the wholesale incorporation of Kato's embodiments into that of the other references rather than what the respective combinations teach and suggest.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Keller, 642 F.2d at 425. One of ordinary skill is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment. *See Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984). We are further mindful that the skilled artisan would "be able to fit the teachings of multiple patents together like pieces of a puzzle" because the skilled artisan is "a person of ordinary creativity, not an automaton." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420–421 (2007). Here, Appellants have not demonstrated the Examiner's proffered combination in support of the conclusion of obviousness would have been "uniquely challenging or difficult for one of ordinary skill in the art." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 421). Therefore, we are not persuaded that the Examiner's use of Kato would change the principle of operation of Jennewine or render Jennewine inoperable for its intended purpose.

In connection with contention (D), Appellants make the naked assertion the prior art fails to teach a series of claim elements without addressing the Examiner's specific findings. *See* Br. 14–15. We agree with the Examiner that such unsupported contentions are unpersuasive of error. Ans. 34–35; *see also* 37 C.F.R. § 41.37(c)(1)(iv) ("A statement which

merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the rejection of independent claims 38 and 54 under 35 U.S.C. § 103(a) over Jennewine, Ma, and Kato, and, for the same reasons, the rejection of independent claim 45 over Jennewine, McKillop, and Kato, together with the rejections of dependent claims 39–44, 46–53, 55–58, and 72–75 which are not argued separately with particularity.¹

DECISION

We affirm the Examiner’s decision to reject claims 38–58 and 72–75.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

¹ Merely restating for a second claim an argument previously presented for a first claim is not an argument for separate patentability.